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STEIN, MCEWEN & BUI, LLP 1400 EYE STREET, NW SUITE 300 WASHINGTON, DC 20005			LERNER, MARTIN	
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DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/736,160	<b>Applicant(s)</b> HEO ET AL.	
	<b>Examiner</b> Martin Lerner	<b>Art Unit</b> 2654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 to 39 and 41 to 51 is/are pending in the application.
- 4a) Of the above claim(s) 9 to 15, 24 to 29, 34 to 39, 41 to 47, and 50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 to 8, 16 to 23, 30 to 33, 48, 49, and 51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. <u>102005</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                                  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____.  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 9 to 15, 24 to 29, 34 to 39, 41 to 47, and 50 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim. Applicants timely traversed the restriction requirement in the reply filed on 29 April 2005.

This application contains claims 9 to 15, 24 to 29, 34 to 39, 41 to 47, and 50 drawn to an invention nonelected with traverse in the reply filed on 29 April 2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 to 8, 16 to 23, 30 to 33, 48, 49, and 51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

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Each of independent claims 1, 16, 30, 48, and 51 contains the amended limitations "the predetermined locations independent of whether the data packs include the additional data" or "wherein the RTI pack is located in the predetermined location independent of whether the RTI pack includes the additional data." These limitations represent new matter. There is not any express or implied support for these limitations in the originally filed Specification. Applicants' Specification discloses data packs disposed in predetermined positions. However, the Specification does not say that the position is "independent of whether the recording unit . . . also includes the additional data" or "whether the RTI pack includes the additional data." An independency between a position of a recording unit and additional data is not disclosed by the originally filed Specification. Thus, these limitations involve new matter.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 to 7, 16 to 22, 48, and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by *Tanaka et al.*

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Regarding independent claim 1, *Tanaka et al.* discloses a recording medium, comprising:

“predetermined recording units, each recording unit having audio data recorded”  
– cells N (“predetermined recording units”) have audio streams recorded in audio packs A (“audio data recorded”) (column 17, lines 22 to 25: Figures 13, 19, 48, and 49);

“data packs designated to store additional data relating to the audio data, each of the data packs being recorded in predetermined locations in corresponding ones of the recording units of the audio data, the predetermined locations being a same position in each of the recording units relative to a beginning of the recording unit and the data packs being placed in the predetermined locations independent of whether the data packs include the additional data” – the first pack in each ACB unit ACBU is an audio control pack A-CONT; an audio control pack A-CONT in each ACB unit ABCU in a DVD-Audio is located at a place corresponding to a third pack in a VCB unit VCBU (column 17, lines 22 to 37: Figures 13, 19, 48, and 49); a control audio pack A-CONT is a data pack “designated to store additional data related to the audio data”; an audio control pack A-CONT has headers, audio character display (ACD) information, audio search data (ASD), and substream identification information (column 18, lines 11 to 22: Figure 15); A-CONT control packs are placed in a first or third position of an ACBU or VCBU, which is a “predetermined position being the same position in each of the recording units relative to a beginning of the recording unit”; also, there is no dependency of position with respect to whether A-CONT control packs contain data or

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no data (e.g. are empty), so the position is "independent of whether the recording unit . . . also includes the additional data", implicitly.

Regarding independent claim 16, *Tanaka et al.* discloses a reproducing method, further comprising:

"reading data from the recording medium in units of the recording units" – a player operates on a DVD-Audio 1; drive unit 2 reads out a signal from the DVD-Audio 1 (column 57, lines 1 to 28: Figure 94);

"reproducing the audio data and the additional data recorded in the read recording units, after relating the additional data to the audio data" – drive unit 2 includes a demodulator, and outputs the demodulation-resultant signal to the reproduced signal processing unit 17 as a reproduced signal (column 57, lines 22 to 28: Figure 94); reproduced information includes real-time information as audio character display (ACD) information ("reproducing . . . the additional data"), which is related to the audio data (column 58, lines 21 to 34: Figure 94).

Regarding independent claim 48, *Tanaka et al.* discloses a reproducing method, further comprising:

"demultiplexing the predetermined units to separate the audio data from data packs having the additional data" – the reproduced signal processor circuit 17 includes an audio and RTI pack detector 9 which receives the reproduced signal from the drive unit 2, and detects audio packs A and real-time information packs RTI in the reproduced

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signal (column 57, line 58 to column 58, line 34: Figure 94); real-time information packs RTI are “data packs having additional data”; still-picture detector 3 detects video packs V and still-picture packs SPCT, and audio and RTI detector 9 detects audio packs A and RTI packs; implicitly, detecting still picture, video, audio, and RTI packs involves “demultiplexing the predetermined units to separate the audio data from data packs having additional data” (column 57, lines 29 to 67: Figure 94).

Regarding claims 2 and 17, *Tanaka et al.* discloses audio packs A and audio control packs A-CONT in each ACB unit ACBU (column 17, lines 22 to 25: Figures 13, 19, 48, and 49); audio packs A have recorded audio data, and audio control packs A-CONT are recorded separately with audio control information.

Regarding claims 3 and 18, *Tanaka et al.* discloses audio packs A and audio control packs A-CONT in each ACB unit ACBU (column 17, lines 22 to 25: Figures 13, 19, 48, and 49); audio control packs A-CONT do not contain any audio data that is reproduced, as audio control packs A-CONT contain only control information; control data need not be audibly or visually reproduced, so it is “additional data” that “does not have . . . to be reproduced” with audio data from audio packs A.

Regarding claims 4, 5, 19, and 20, *Tanaka et al.* discloses that control data may be real-time information, so audio control packs A-CONT correspond to real-time information packs RTI (column 57, line 58 to column 58, line 34: Figure 94); real-time information includes audio character display (ACD) information, which is displayed (column 58, lines 21 to 34); audio character display (ACD) information is text describing

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a tune name (column 18, lines 11 to 39: Figures 15 and 16); audio search data (ASD) synchronizes a present time to an absolute time of a related title (column 18, lines 11 to 39: Figures 15 and 16; column 19, lines 11 to 35: Figure 18).

Regarding claims 6 and 21, *Tanaka et al.* discloses each audio control pack A-CONT stores managing information representing a title and a play time (column 20, lines 10 to 19); audio search data (ASD) has playback time of a related track and an absolute time of the related title (column 19, lines 11 to 35: Figure 18); real-time information is read from real-time information packs RTI to display audio character display information (column 58, lines 21 to 34), thus, titles are displayed as text when recording units corresponding to the titles are played.

Regarding claims 7 and 22, *Tanaka et al.* discloses that control data may be real-time information, so audio control packs A-CONT correspond to real-time information packs RTI (column 57, line 58 to column 58, line 34: Figure 94); each ACBU or VCBU has a plurality of audio packs A ("each recording unit has a plurality of audio packs") (Figures 13, 19, 48, and 49); an audio control pack A-CONT is located in a first position in each ACBU (Figures 13, 19, 48, and 49).

Regarding claim 49, *Tanaka et al.* discloses the reproduced signal processor circuit 17 includes an audio and RTI pack detector 9, which receives the reproduced signal from the drive unit 2, and detects audio packs A and real-time information packs RTI in the reproduced signal (column 57, line 58 to column 58, line 34: Figure 94); thus, RTI packs (or audio control packs A-CONT) are separated from audio packs A for processing.



***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 23, 30 to 33 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Tanaka et al.* in view of *Ema et al.*

Concerning independent claims 30 and 51, *Tanaka et al.* discloses a reproducing apparatus with an audio signal processor and an RTI signal processor (Figure 94), but does not expressly show all the structural details for a reproducing apparatus.

However, *Ema et al.* discloses a reproducing apparatus further comprising:

“a reproducing controller reading an audio object (AOBU) which is one of the recording units” – system controller 100 provides control signals for controlling an audio reproducing process (column 9, lines 22 to 45: Figure 4);

“a demultiplexor demultiplexing an audio pack in which audio data is recorded and an RTI pack in which additional data is recorded, from the read AOBU” – demultiplexer 86 extracts audio packs 230 and RTI packs 231; RTI packs 231 contain RTI data (including text information, tempo information 53 and beat information 54) (column 9, lines 22 to 46: Figures 1 and 4);

“an audio signal processor decoding the audio pack demultiplexed by the demultiplexor to output the audio data stored in the audio pack” – audio decoder 93

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decodes audio information from audio packs 230 (column 9, lines 22 to 46: Figures 1 and 4);

“an RTI signal processor decoding the RTI pack demultiplexed by the demultiplexer to output additional data stored in the RTI pack in relation to the audio data from the audio pack” – RTI decoder 96 decodes RTI data output from demultiplexer 86 to provide beat information (column 9, lines 22 to 46: Figures 1 and 4).

Concerning independent claims 30 and 51, one skilled in the art would know that still picture, video detector pack 3A and audio, RTI pack detector 9 are equivalent to a demultiplexor, and control unit 23 is equivalent to a reproducing controller in *Tanaka et al.* (Figure 94) However, *Ema et al.* teaches a related apparatus and method of reproducing music together with information representing beat of music, where a reproducing apparatus enables generation of a signal representing tempo of music. (Column 5, Lines 3 to 8) It would have been obvious to one having ordinary skill in the art to include the elements of an audio reproducing processor as taught by *Ema et al.* in the signal processing apparatus of *Tanaka et al.* for the purpose of reproducing beat information for music.

Concerning claims 8, 23, and 33, *Tanaka et al.* discloses that an audio control pack A-CONT, corresponding to a real-time information (RTI) pack is in a first location with respect to an ACBU, but in a third position with respect to a VCBU. (Figures 13 and 48) Thus, embodiments are disclosed where an A-CONT pack or an RTI pack is offset by two units from a cell head. It is a matter of design choice exactly where an A-CONT pack or RTI pack is located in a cell N. *Tanaka et al.* suggests an A-CONT pack

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may be located at a first or third position for each cell, but does not expressly disclose placing an A-CONT pack in a second position. However, variable offset would be an obvious expedient of design choice, in the absence of unexpected results. The most logical place to put a control pack would be in a first position, but as *Tanaka et al.* also suggests putting a control pack in a third position, it would be an obvious expedient to place a control pack in a second position, as a matter of design choice, in the absence of unexpected results.

Concerning claim 31, *Tanaka et al.* discloses each audio control pack A-CONT stores managing information representing a title and a play time (column 20, lines 10 to 19); audio search data (ASD) has playback time of a related track and an absolute time of the related title (column 19, lines 11 to 35: Figure 18); real-time information is read from real-time information packs RTI to display audio character display information (column 58, lines 21 to 34), thus, titles are displayed as text when recording units corresponding to the titles are played.

Concerning claim 32, *Tanaka et al.* discloses that control data may be real-time information, so audio control packs A-CONT correspond to real-time information packs RTI (column 57, line 58 to column 58, line 34: Figure 94); each ACBU or VCBU has a plurality of audio packs A (Figures 13, 19, 48, and 49); an audio control pack A-CONT is located in a first position in each ACBU (Figures 13, 19, 48, and 49).

***Response to Arguments***

Applicants' arguments filed 23 September 2005 have been fully considered but they are not persuasive.

Firstly, Applicants argue that the claims are enabled by the Specification, and fully comply with 35 U.S.C. §112, 1<sup>st</sup> Paragraph. Applicants state that support for the amendments is found at Page 5, Lines 9 to 11 of the Specification, which discloses that an AOBU, in which no additional data to be reproduced in relation to an audio pack A\_PCK exist, has an RTI pack RTI\_PCK. This position is not persuasive.

Applicants' Specification, as cited on Page 5, Lines 9 to 11, do not comply with the written description requirement under 35 U.S.C. §112, 1<sup>st</sup> Paragraph, for the limitation of "the predetermined locations independent of whether the data packs include the additional data" or "wherein the RTI pack is located in the predetermined location independent of whether the RTI pack includes the additional data." These limitations are new matter. The citation on Page 5, Lines 9 to 11 of the Specification was reviewed, but does not provide a written description of these limitations, either expressly or implicitly. At the outset, it is noted that Applicants have apparently cited the wrong section, or that the page and line number cited by Applicants correspond to another version of the Specification. The Patent and Trademark Office has a copy of Applicants' Specification, where Page 5, Lines 9 to 11, states: "The embodiments of the present invention are provided in order to more completely explain the present invention to anyone skilled in the art. FIG. 1 is an example of a data structure recorded on a recording medium". Evidently, Applicants' citation should refer to Page 6, Lines 7 to 9,

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of the Specification, of the copy for the United States Patent and Trademark Office, which states: "Also, an AOB, in which no additional data to be reproduced in relation to an audio pack A\_PCK exist, has an RTI pack RTI\_PCK in which no data is recorded."

However, saying that there are at least some RTI packs in which no additional data is recorded is not the same as saying that the data packs are placed in predetermined locations independent of whether the data packs include the additional data. Applicants' Specification does not say anything either expressly or implicitly about a relationship of either dependency or independency between the location of data packs and whether or not the data packs contain additional data. All Applicants' Specification suggests is that at least some data packs may not have data recorded. One having ordinary skill in the art might reason that a predetermined location of data packs may have nothing to do with whether a data pack contains additional data, if nothing about a dependency relationship between location and presence of additional data is disclosed, but it does not necessarily follow that there is no relationship. Applicants are improperly attempting to add a limitation to the claims to obtain subject matter not disclosed by the originally filed Specification, and thereby argue that the prior art does not expressly disclose the improperly added limitation. The limitations of "the predetermined locations independent of whether the data packs include the additional data" or "wherein the RTI pack is located in the predetermined location independent of whether the RTI pack includes the additional data" represent new matter.

Secondly, Applicants argue that *Tanaka et al.* fails to teach or suggest that the packs such as the control packs are located in predetermined locations, the data packs

being placed in the predetermined locations independent of whether the data packs include the additional data.

However, *Tanaka et al.* clearly does disclose placing control packs in predetermined locations as shown in Figures 13 and 19. If the digital signal contains both audio and video components, then an audio control pack A-CONT is always placed in a third position, as shown in Figure 13. If the digital signal contains only audio components, then an audio control pack A-CONT is always placed in a first position, as shown in Figure 19. (Column 17, Lines 22 to 37: Figures 13 and 19) Applicants present a mere allegation of patentability, without setting forth reasons the prior art does not contain clearly disclosed features.

Moreover, *Tanaka et al.* may be construed to disclose control packs with locations independent of whether the data packs include additional data. *Tanaka et al.* clearly discloses that audio control packs are always placed in the same predetermined location for all circumstances. There is no suggestion that the predetermined locations of audio control packs may vary in any situation. If a location of audio control packs is always the same under all conditions, then it follows the location of audio control packs does not vary even if the audio control packs do not contain additional data. One having ordinary skill in the art would recognize that it is inherent that a location of audio control packs is independent of whether the audio control packs include additional data, because a location of audio control packs is always the same under all eventualities for *Tanaka et al.* There is nothing to suggest that the location of audio control packs will in any situation vary from either the first or third location of *Tanaka et al.* It is known that

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there are some instances where packs may contain no data for audio and video, e.g. where a pack represents data at a very beginning of a movie or compact disk when a movie or musical selection has not yet begun. One skilled in the art would understand that *Tanaka et al.* may be construed to inherently disclose that the predetermined locations of audio control packs is independent of whether additional data is included in the audio control packs.

Therefore, the rejections of claims 1 to 8, 16 to 23, 30 to 33, 48, 49, and 51 under 35 U.S.C. §112, 1<sup>st</sup> Paragraph, as failing to comply with the written description requirement, of claims 1 to 7, 16 to 22, 48, and 49 under 35 U.S.C. §102(e) as being anticipated by *Tanaka et al.*, and of claims 8, 23, 30 to 33 and 51 under 35 U.S.C. §103(a) as being unpatentable over *Tanaka et al.* in view of *Ema et al.*, are proper.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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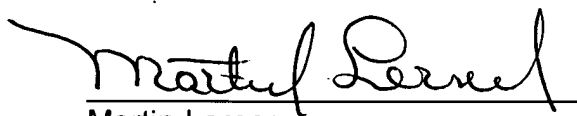
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin Lerner whose telephone number is (571) 272-7608. The examiner can normally be reached on 8:30 AM to 6:00 PM Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil can be reached on (571) 272-7602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML  
10/28/05

A handwritten signature in black ink, appearing to read "Martin Lerner", written over a horizontal line.

Martin Lerner  
Examiner  
Group Art Unit 2654